

REMARKS

1. Office Action Summary:

The Office Action alleges that the Applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 because “copendency between the current application and the prior application is required.” Further, the Office Action rejected claims 1-9, 11-21, 23-24, 26-41, 43-56, 58-68 and 70-76 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,508,710 to Paravia et al. (*Paravia*), which issued on January 21, 2003, from an application filed on December 27, 1999. The Office Action further rejected claims 10, 22, 25, 42, 57 and 69 as being unpatentable over *Paravia*, under 35 U.S.C. § 103(a).

The Applicants respectfully traverse the Examiner’s comments that the Application does not properly claim priority to an earlier filing date. Rather, the Application does properly claim priority to the earlier filed applications, and therefore, none of the cited art can be deemed as prior art against this application.

2. Examiner Telephone Conference Summary:

The Applicants appreciate the courtesy extended by the Examiner to Applicants’ counsel in a telephone conversation held on May 18, 2004, regarding the Applicants’ proper claim to priority to the earlier filed applications. As discussed in the May 18, 2004, telephone conversation, and as illustrated below via the attached exhibits, this application, and all previous applications from which priority is claimed, were copendent with their respective parent applications. In other words, the chain of priority has not been broken.

The Examiner requested that the Applicants submit in their response to the Office Action, an explanation of the Applicants' claim for priority. The Applicants believe that the explanation provided below, together with the supporting exhibits attached hereto, provide the requested explanation, which traverses the Office Action's allegation that the claim to priority is improper.

3. Priority:

As noted above, the Office Action alleges that the Applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 because "copendency between the current application and the prior application is required." The application claims the benefit of U.S. Patent Application, Serial No. 09/854,438, filed on May 11, 2001, which is a continuation of U.S. Patent Application, Serial No. 09/612,476, filed on July 7, 2000, and U.S. Provisional Patent Application, Serial No. 60/145,068, filed on July 9, 1999.

U.S. Patent Application, Serial No. 09/612,476 was filed on July 7, 2000, which was within one year of the filing date of the July 9, 1999, U.S. Provisional Patent Application. (See Exhibit A and Exhibit B).

A Notice To File Missing Parts for U.S. Patent Application, Serial No 09/612,476, was mailed on October 11, 2000, which designated an extendable two-month time period in which to respond. (See Exhibit C). Accordingly, on May 11, 2001, a 5-month Petition For Extension Of Time under 37 C.F.R. § 1.136(a) was filed (see Exhibit D) concurrently with a Request For A Retention Of Abandoned Application under 35 C.F.R. § 1.21 (l). (See Exhibit E). The 5-month Petition For Extension Of Time extended the time period to respond to the Notice To File Missing Parts to May 11, 2001. In that respect, the Applicants further filed a U.S. Continuation Patent Application on May 11, 2001, U.S. Serial No. 09/854,438. (See Exhibit F). Thus, on

May 11, 2001, when the Continuation Patent Application was filed, it was co-pending with U.S. patent application, Serial No. 09/612,476.

Another Notice To File Missing Parts for U.S. Application Serial No. 09/854,438 was mailed on May 29, 2001, which designated an extendable two month time period in which to respond. (See Exhibit G). Accordingly, on December 27, 2001, the Applicants filed a 5-month Petition For Extension Of Time Under 37 C.F.R. § 1.136(a) (see Exhibit H) concurrently with a Request For A Retention Of Abandoned Application under 35 C.F.R. § 1.21 (I). (See Exhibit I). The 5-month Petition For Extension Of Time extended the time period to respond to the Notice To File Missing Parts to December 29, 2001. In that respect, the Applicants further filed the presently pending U.S. Patent Application on December 27, 2001. (See Exhibit J). Thus, on December 27, 2001, when the present U.S. Patent Application was filed, it was co-pending with its parent, U.S. Serial No. 09/854,438.

In summary, each of the applications in the chain of priority from which the present application claims priority were co-pending with their parent application when filed. Thus, priority for the present application is properly claimed back to July 9, 1999.

It is noted that the above procedure was performed in consultation with and under the guidance of Ms. Magdalen Greenleaf of the U.S. Patent and Trademark Office based upon telephone conversations with her in or around May 2001.

4. Rejection Of Claims 1-9, 11-21, 23-24, 26-41, 43-56, 58-68 and 70-76 Under 35 U.S.C. § 102(e):

The Office Action rejects claims 1-9, 11-21, 23-24, 26-41, 43-56, 58-68 and 70-76 over U.S. Patent No. 6,508,710 to Paravia et al. (*Paravia*) as anticipated under 35 U.S.C. § 102(e). The *Paravia* Patent issued on January 21, 2003 from an application filed on December 27, 1999. As explained above, the present application claims a priority date of July 9, 1999. In this regard,

Parvia is not prior art. Thus, it is respectfully improper to reject any of the claims over *Paravia*, and the Applicants believe that claims 1-9, 11-21, 23-24, 26-41, 43-56, 58-68 and 70-76 are therefore allowable.

In light of the above, the Applicants do not believe it necessary to address the substance of the rejection over *Paravia*. Nevertheless, should it be necessary to do so, the Applicants reserve the right to respond substantively to the rejection over *Paravia*.

5. Rejection Of Claims 10, 22, 25, 42, 57 and 69 Under 35 U.S.C. § 103(a):

The Office Action further rejects claims 10, 22, 25, 42, 57 and 69 under 35 U.S.C. § 103(a) as being unpatentable over *Paravia* (alone) under 35 U.S.C. § 103(a). For the same reasons stated above as to why the rejection of claims under 35 U.S.C. § 102(e) using the *Paravia* reference is improper, i.e, due to the application's priority claim, the Applicants believe that the obviousness rejection of claims 10, 22, 25, 42, 57 and 69 is improper, and that these claims also allowable.

In light of the above, the Applicants do not believe it necessary to address the substance of the rejection over *Paravia*. Nevertheless, should it be necessary to do so, the Applicants reserve the right to respond substantively to the rejection over *Paravia*.

CONCLUSION

The Applicants have made an earnest and bona fide effort to clarify the issues before the Examiner and to place this case in condition for allowance. In view of the foregoing discussions, it is clear that the Application's claim to priority *is* proper, and the cited art is *not* prior art. Therefore, reconsideration and allowance of all of the pending claims are believed to be in order, and an early Notice of Allowance to this effect is respectfully requested. If the Examiner should have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 712-8311. The undersigned attorney can normally be reached Monday through Friday from about 9:30 AM to 5:30 PM Pacific Time.

Respectfully submitted,

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